REMARKS

Applicants wish to thank the Examiner for the attention accorded to the instant application.

Claims 41-67 and 83-89 are pending in the application.

I. Claim Rejections – 35 U.S.C. §103

The Examiner has rejected pending claims under 35 U.S.C. §103(a) as being unpatentable over variously U.S. Patent No. 4,749,261 to McLaughlin et al. ("McLaughlin") in view of U.S. Patent No. 6,172,720 to Khan et al.("Khan"), U.S. Patent No. 6,049,366 to Hakemi et al. ("Hakemi"), U.S. Patent No. 4,131,582 to Coker ("Coker"). The Examiner has used other various combinations of references Other various combinations of references such as U.S. Patent No. 4,961,532 to Tangney ("Tangney"), U.S. Patent No. 4,097,130 to Cole, Jr. ("Cole"), U.S. Patent No. 4,579,422 to Simoni et al. ("Simoni"), U.S. Patent No. 6,171,663 to Hanada et al. ("Hanada"), U.S. Patent No. 6,022,547 to Herb et al. ("Herb"), and U.S. Patent No. 5,691,795 to Doane et al. ("Doane") and U.S. Patent No. 5,667,897 to Hashemi et al. ("Hashemi")

Applicants respectfully traverse. The Examiner is reminded that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references) must teach or suggest all of the claim limitations. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

Every element of a claimed invention may be found in the prior art. In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343 (Fed. Cir. 1998).

Applicants respectfully submit that Examiner is practicing speculation and impermissible hindsight when combining references to formulate an obviousness rejection. "It is difficult but necessary that the decisionmaker forget what he or she has been taught ... about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For instance, McLaughlin is directed to a shatter-proof liquid crystal panel. As Examiner admits, there is no teaching or suggestion in McLaughlin for using polymer stabilized cholesteric liquid crystal ("PSCT"). As stated in the Background of the application, PSCT has many advantages for use in an electro-optical glazing structure that are not apparent just from the use of general liquid crystals. For instance, as Examiner admits, PSCT has a low voltage requirement, simplicity of fabrication, haze-free normal modes, and lack of index mismatching. None of these advantages are cited or discussed in McLaughlin.

The Examiner cites Hakemi for teaching the use of PSCT and its advantages over the PDLC and conventional liquid crystal. However, there is no motivation or suggestion in Hakemi to combine the teachings of Hakemi with the teachings of McLaughlin. Particularly, McLaughlin is primarily directed to a shatter-proof liquid crystal panel. Applicants submit that one of ordinary skill in the art at the time the invention was made would not have combined the teachings of Hakemi with McLaughlin to arrive at an electro optical glazing structure primarily for the use of privacy window glazings. Instead, Applicants submit that when one of ordinary skill in the art is presented with the teachings of Hakemi and McLaughlin, the teachings of McLaughlin directed towards a shatter-proof liquid crystal panel would not have been fulfilled by the use of PSCT. There is no inherent advantages of using PSCT in a shatter-proof liquid crystal panel.

The Examiner is reminded that obviousness cannot be established by hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). It is the prior art itself, and not the Applicants' achievement, that must establish the obviousness of the combination.

Similarly, the Examiner fails to cite the motivation or suggestion of combining McLaughlin variously with (1) Tangney, Khan and Coker, (2) Hakemi, Cole and Khan, (3) Simoni, Khan, Coker and Hanada, (4) Khan, Tangney, Hakemi, Cole, Coker, Hanada, Simoni and Doane, and (5) Khan, Tangney, Hakemi, Cole, Coker, Simoni and Hashemi. The Examiner is reminded that motivation or suggestion to combine the individual references must be identified for each selected combination of references. When an obviousness determination relies on the combination of two or more references, there must be some suggestion or motivation to combine the references. The suggestion to

combine may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved. When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. WMS Gaming, Inc. v. International Game Technology, 184 F.3d 1339, 1355 (Fed. Cir. 1999).

II. Conclusion

For the foregoing reasons, Applicants respectfully submit that all pending claims 41-67 and 83-89 are now in condition for allowance. Early notice to that effect is earnestly solicited.

Respectfully submitted,

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